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Bernd Simon

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EXAMINER

SCHAPER, MICHAEL T

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

06/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/757,929	Applicant(s) SIMON ET AL.	
	Examiner MICHAEL T. SCHAPER	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9, 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to all current claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claimed phrase “**particularly the proximal femur**” (claim 19, line 2) renders the claims indefinite because of its ambiguity and scope-changing nature with respect to the metes and bounds covered by the claim language. See MPEP 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by McGuire et al. (US 5374270).

As to claims 7-8, McGuire discloses a system for forming a channel in a bone comprising a guide wire (12) having a leading and trailing end; a rotatable boring tool (FIG. 1 sans 12) having a wall (outer 11/14) surrounding an axial bore (17) for slidably receiving said guide wire, said tool having a first end including a cutting element (at 11) and a drive end (near 11) capable of connection to a power source, said wall adjacent said drive end having an elongated opening (16) therethrough in communication with said bore (see FIG. 2) capable of permitting viewing sliding movement of said guide wire trailing end during rotation of said boring tool; wherein said opening is in the form of an elongated slot (see FIG. 2).

As to claims 19-21, McGuire discloses a boring tool for bone comprising a shank (11/14) having a rotatable cutting tool (11) at a first distal end thereof, the shank and cutting tool having a cannulation (17) therethrough, the cutting tool having a drive portion at a proximal end (proximal 14) thereof; and a guide wire (12) slidably received within the cannulation in the shank and cutting tool and having a trailing end capable of being viewed through a window (16, see FIG. 2) in the shank; wherein the window extends parallel to the cannulation in the shank (see FIG. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al. (US 5374270).

McGuire discloses the claimed invention except for a pair of diametrically opposed elongated slots are located on opposite sides of said wall and extend in parallel. However, McGuire discloses the system including one or more elongated slots (ref. no. 16) in order to permit tightening thereof.

Accordingly, at the time the invention, it would have been obvious to a person of ordinary skill in the art to have constructed the system of McGuire to have a pair of elongated slots plurality of bushings, since the mere duplication of the essential working parts of a device involves only routine skill in the art, and in this case, optimize the chuck tightening.

Furthermore, it would have been obvious to have made the slots parallel and diametrically opposed as this would further optimize the chuck tightening and because the original slot in McGuire is already present in parallel fashion.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al. (US 5374270), as applied to the rejections of claims 7-8 and then claim 9 above, in view of Gardner (US 3216288).

McGuire discloses the claimed invention except for the shank having a radially outwardly extending slideable lock portion between the shank distal end and the drive

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portion, the distal end of the shank spaced distally of the lock portion and the drive portion spaced proximally of the lock portion.

Gardner discloses a cutting tool system having a radially outwardly extending slideable lock portion (30, FIGS. 1, 3, and 7a) between the shank distal end and the drive portion (clearly shown between opposite ends of the device), the distal end of the shank spaced distally of the lock portion and the drive portion spaced proximally of the lock portion (see FIG. 1) for increased control of the depth in the procedure.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to have modified the device of McGuire with a cutting tool system having a radially outwardly extending slideable lock portion between the shank distal end and the drive portion, the distal end of the shank spaced distally of the lock portion and the drive portion spaced proximally of the lock portion in view of Gardner for increased control of the depth in the procedure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL T. SCHAPER whose telephone number is (571)270-7413. The examiner can normally be reached on M-F, 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on (571)272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T. S./
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775